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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,744	11/28/2000	John Thaddeus Pienkos		8432

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EXAMINER	
NGUYEN, CUONG H	

ART UNIT	PAPER NUMBER
3661	

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/724,744	PIENKOS, JOHN THADDEUS	
	Examiner	Art Unit	
	CUONG H. NGUYEN	3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17 and 21-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17, 21-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the communication received on 9/13/2004; which papers have been placed of record.

2. Claims 1-17, 21-23 are pending in this application.

RESPONSE:

3. Since the pending claims are still obvious based on 35 USC 103(a) according to previous Office Action's cited prior art (for combination of the claimed subject matters - please note that cited prior art are within the field of application then one with ordinary skill in the art can modify the cited references or to combine their teachings according to motivations inherently or explicitly in these cited references' suggestions); the examiner submits that there is no novelty concept of this pending application from cited references. The arguments submitted on 9/13/2004 cannot overcome such obviousness on 35 USC 103(a).

On page 10 (of the fax submitted 9/18/2004):

- 1st para., the applicant argues that Business Wire and Margaret Quan fail to suggest all of the features, please identify which feature not suggested by those references.

Furthermore, critical concept of the claims are read-on by cited references and no reasonable distinguishing limitation has been made in claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ 2d 1057 (Fed. Cir. 1993); therefore, the applicant can not argue limitations not in the claims (i.e., for a particular application in banking - please note that independent claims 1, 13, 21 DO NOT CITED "intellectual property investment bank" as argued on 1st para. of page 4) since once becoming a patent, it is the inventors intellectual property and would be enforced according to the law.

On page 10, para. 3, (of the fax submitted 9/18/2004) the applicant argues that the claims recite methods in which there are "dual transfers" of interests in intellectual property (through a "middle man") - this is not inventive because transferring intellectual property already are fundamental applications in business.

The examiner respectfully submits that the obviousness question cannot be approached on basis that skilled artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclosed. In re Jacoby, 135 USPQ 317, 319 (CCPA 1962). Conclusion of obviousness maybe made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 163 USPQ 545, 49 (CCPA 1969). The Court in "In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (CAFC 1988)"

plainly sets forth that the obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary artisan in the art. See also In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (CAFC 1992). More important, the reference does not need to provide explanation about what artisan would know as evidenced by standard textbook. In re Opprecht, 12 USPQ2d 1235 (CAFC 1989).

The examiner further submits that there would be many interferences because he examined many applications of this subject matter previously (un-published applications).

4. General concepts of transferring intellectual property are also already taught by these following articles:

- Weber, Metering Technologies for Digital Intellectual Property, A Report to the International Federation of Reproduction Rights Organizations, pp. 1-29, Oct. 1994, Boston, MA, USA.

- Linn, R.J., "Copyright and Information Services in the Context of the National Research and Education Network.sup.1," IMA Intellectual Property Project Proceedings, Jan. 1994, vol. 1, Issue 1, pp. 9-20.

- Griswold, G.N., "A method for protecting copyright on networks", IMA Intellectual Property Project Proceedings, Jan. 1994, vol.1, issue 1, pp. 169-178.

In summary, the examiner is unpersuasive of submitted arguments; the previous rejections on obviousness are maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-17, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over an article of BusinessWire (4/22/1999), in view of Margaret Quan (EE Times).

A. As to claims 1, 13, 17, 21-23: BusinessWire (4/22/1999) discloses that pl-x.com has been practicing a method of facilitating the transfer of intellectual property, obviously comprising:

obtaining at a computer system of a first entity information concerning intellectual property in which an interest is available for transfer (the "available intellectual property")

from a second entity; and transferring the interest in the available intellectual property by concluding an agreement between the first and second entities, wherein the agreement is representative of an acceptance of an offer concerning the transferring of the interest in the available intellectual property and consideration for the transferring of the interest, and wherein the interest in the available intellectual property that is transferred to the first entity is intended to be transferred from the first entity to a third entity (this way of transferring is merely indirect, instead of going from a seller (2nd entity) to a buyer (3rd entity), a transferred object goes from the 2nd entity to a 3rd entity via a 1st entity (middle man - in this case, that 1st entity is pl-x.com) (see BusinessWire (4/22/1999), page 1, 5th para).

According to Margaret Quan, Yet2.com has also been an Internet site for sale, license, review, evaluate intellectual properties online, where buyer, seller exchange/deal IP via a broker (Yet2.com).

It would be obvious to one with ordinary skill in the art at the time of the invention to understand the mission of website pl-x.com and yet2.com to derive above claimed limitations because the above claimed ideas are merely pl-x.com and yet2.com area of business of being a middle man for

exchanging/valuating/reviewing IP assets with the use of Internet for all further communications - artisans would understood that the only IPs posted in these sites are what available for exchange to interested parties.

The rationales and reference for rejection of claim 1 are incorporated for the following analysis:

B. As to claims 2, 14: BusinessWire (4/22/1999) discloses that pl-x.com has been obtaining information concerning the available intellectual property relates to the nature of the available intellectual property; and processing the information relating to the nature of the available intellectual property, wherein processing includes reviewing the information; and obtaining additional information concerning the interest in the available intellectual property that is available for transfer (the "available interest") after completing the processing (see BusinessWire (4/22/1999), page 2, 2nd para).

C. As to claim 3: BusinessWire (4/22/1999) discloses that pl-x.com allows for a determination concerning a financial value of the available intellectual property, the technological scope of the available intellectual property (by assist for searching appropriate fields), the market/product coverage of the available intellectual property (potential of making benefit) (see Margaret Quan, page 1, last para.), the

ownership/possessory status of the available intellectual property, and whether there have been past inquiries received at the computer system of the first entity concerning the available intellectual property and, if so, the nature of the past inquiries - this checking/reviewing obviously has been done by reviewing process and making comparisons with current needs/state of the art by the reviewer/buyer with the use of pl-x.com or yet2.com websites.

D. As to claim 4: BusinessWire (4/22/1999) discloses that it is obvious that pl-x.com has been processing the additional information concerning the available interest to determine if the available interest is desired for transfer by the first entity; generating a proposed agreement for transferring the available interest if the available interest is determined to be desired for transfer; and providing the proposed agreement from the computer system of the first entity to another computer system of the second entity, wherein the computer system of the first entity is at least one of a computer system owned by the first entity and a server computer of an independent entity that is hosting a website for the first entity.

E. As to claim 5: BusinessWire (4/22/1999) discloses that it is obvious that pl-x.com has been practicing of receiving an acceptance at the computer system of the first entity and

providing an acceptance from the computer system of the first entity, and further comprising providing payment upon the concluding of the agreement.

F. As to claim 6: BusinessWire (4/22/1999) discloses that pl-x.com has been receiving an objection to the proposed agreement at the computer system, and responding to the objection by generating a new proposed agreement and providing the new proposed agreement from the computer system.

It would be obvious to one with ordinary skill in the art at the time of the invention to understand the mission of website pl-x.com and yet2.com because the above claimed ideas are merely their own area of business of being a middle man for exchanging IP assets with the use of Internet for all communications.

G. As to claim 7: BusinessWire (4/22/1999) discloses that pl-x.com has been obtaining information concerning the available intellectual property relates to the interest in the available intellectual property that is available for transfer.

It would be obvious to one with ordinary skill in the art at the time of the invention to understand the mission of website pl-x.com and yet2.com because the above claimed ideas are merely their own area of business of being a middle man for exchanging IP assets with the use of Internet for all

communications - artisans would understood that the only IPs posted in these sites are what available for exchange.

H. As to claim 8: BusinessWire (4/22/1999) discloses that it is obvious that pl-x.com has been practicing of receiving an initial contact at the computer system; providing descriptive information from the computer system concerning the first entity; obtaining identification information at the computer system concerning the second entity; and providing an identifier for future access.

It would be obvious to one with ordinary skill in the art at the time of the invention to understand the mission of website pl-x.com and yet2.com because the above claimed ideas are merely their own area of business of being a middle man for exchanging IP assets with the use of Internet for all communications.

I. As to claim 9: : BusinessWire (4/22/1999) disclose that pl-x.com has been practicing a method of facilitating the transfer of intellectual property, obviously comprising:

- recording, on a database information regarding the interest in the available intellectual property that is transferred in accordance with the concluded agreement;

- processing the information recorded on the database so that at least a portion of the processed information can be utilized

as descriptive information to be provided from the computer system of the first entity to an IP exchange computer system.

It would be obvious to one with ordinary skill in the art at the time of the invention to understand the mission of website pl-x.com and yet2.com because the above claimed ideas are merely their own area of business of being a middle man for exchanging IP assets with the use of Internet for all communications.

J. As to claim 10: BusinessWire (4/22/1999) disclose that pl-x.com has been practicing a method of facilitating the transfer of intellectual property, obviously comprising:

- checking a database of the computer system of the first entity to determine the existence of a relevant past inquiry regarding intellectual property conforming to the available intellectual property that is transferred in accordance with the concluded agreement; and
- contacting an IP desirer computer system from which the computer system of the first entity received such a relevant past inquiry.

It would be obvious to one with ordinary skill in the art at the time of the invention to understand the mission of website pl-x.com and yet2.com because the above claimed ideas

are merely their own area of business of being a middle man for exchanging IP assets with the use of Internet for all communications - artisans would understood that by reviewing past inquiries (a means to know who is having an interest), a list of buyers would be obtained.

K. As to claim 11: BusinessWire (4/22/1999) disclose that pl-x.com has been practicing a method of facilitating the transfer of intellectual property, obviously comprising:

- contacting an IP desirer computer system from which the computer system of the first entity received such a relevant past inquiry.

- either the obtained information concerning the available intellectual property is obtained at the computer system from an IP exchange computer system, and the method further comprises providing a bid after obtaining the information concerning the available intellectual property (pl-x.com practices about online bid placements);

- or the method further comprises providing to the IP exchange computer system information regarding an intellectual property interest and then receiving a bid for the intellectual property interest (see BusinessWire (4/22/1999), page 2, 2nd para.).

It would be obvious to one with ordinary skill in the art at the time of the invention to understand the mission of website pl-x.com and yet2.com because the above claimed ideas are merely their own area of business of being a middle man for exchanging IP assets with the use of Internet for all communications.

L. As to claim 12: BusinessWire (4/22/1999) obviously suggests that an available intellectual property includes an intellectual property asset selected from among a patent, a trademark, a copyright, a patent application, an invention, and a trade secret (these are commonly understood by one with skill in the art as IP assets); and the interest in the available intellectual property includes at least one of a license to a license to an IP asset..

M. As to claim 15: It contains similar limitations as in a combination of claims 3, 9 and 10; therefore, similar rationales and references set forth in rejections of claims 3, 9, and 10 are applied on obviousness (please note that "providing a search request" obviously have been done while doing "checking/determination via available database" (see BusinessWire's article about pl-x.com or Margaret Quan's article about yet2.com).

N. As to claim 16: It obviously contains similar limitations as in a combination of claims 1 and 3; therefore, similar rationales and references set forth in rejections of claims 1, and 3 are applied on obviousness.

It would be obvious to one with ordinary skill in the art at the time of the invention to understand the mission of website pl-x.com and yet2.com because the above claimed ideas are merely their own area of business of being a middle man for exchanging IP assets with the use of Internet for all communications. Those websites use database to review an IP need (such as by checking past inquiries, a current state of the art of that IP, an urgent need for that IP's application), and transferring an IP license between a seller and a buyer via a middle man/broker.

The examiner further submits that the claimed concept is an old and well-known subject matter of manually transferring intellectual property to teach that claimed process with the advantage of the Internet through IP Working Group. The claimed concept of technology transfer was used in corporation merger (for instance), wherein all properties of a company (including intellectual property) are transferred to a new "owner" (e.g., Westinghouse Electric Company in Baltimore-Washington International Airport was bought by Norththrop-Grumman

Corporation in 1995, a transition team (or "a middle man" was involved to make all negotiations/transitions happened smoothly - similar to changing a governmental cabinet at the White House between a Democrat president and a Republican president). The fact that transaction is on the Internet - this is not inventive concept according to In re Venner - The court held that providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 120 USPQ 193, 194 (CCPA 1958).

All pending claims are not patentable, and **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than

SIX MONTHS from the date of this final action.

6.Remark: standard dictionaries already defines what is claimed:

- intellectual property: concept of legal protection for original creations, encompassing copyright, trademarks, patents.

- copyright: The legal protection against copying and the specific rights allowing copying given to original works, which may be in printed or photographically or electronically stored words, music, visual arts, and performing arts. The purpose of copyright is not just to protect the rights, but to establish the rules under which copies or portions may be made to make a work more widely available. Copyright extends to electronic representations of these forms, too, although the laws governing new electronic copies in such forms as search engine indexes and browser caches needs better definition. Copyright exists on all original works from the moment they are published, whether formally registered or not and whether or not copyright markings appear on the works. Copyrights probably apply to public postings in e-mail, message bases, and newsgroups, but the law is not well tested in these areas. Copyrights are observed by most countries in the world. For further information on copyrights, see our Copyright Guidance page, and visit the Delphi Personal Law Forum for current discussions.

- Technology Transfer: a simple definition is a movement of technology or knowledge.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 703-305-4553. The examiner can normally be reached on 7am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached on 703-305-8233. The fax phone number for the organization where this application is assigned is 703-305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHN

Cuonghnguyen

CUONG H. NGUYEN
Primary Examiner
Art Unit 3661